

REMARKS

Claims 11, 15, and 19 have been amended to overcome the examiner's objection or rejection of these claims under 35 U.S.C. 112 second paragraph, and, thus, this rejection is believed to be overcome. Also, claim 1 has been amended to clarify and make specific what was implicit, i.e. that the two modes are operational modes. It is not believed that these amendments change the scope of the claims.

Claims 1-2 and 4-8 have been rejected under 35 U.S.C. 102 (b) as being anticipated by U.S Patent 5,805,597 to Edem, hereinafter Edem. This rejection is not thought to be well taken.

As stated in the previous amendment, "The examiner states that Edem teaches 'determining eligibility of a system to enter a low power mode based on operator generated signals, time of day, or non-use of the system for a period of time, or a combination thereof' and cites col. 8 lines 44-67, and col. 9, lines 1-6 of Edem. It is respectfully submitted that Edem teaches neither the eligibility criteria nor components (claim 1) nor a protocol (claim 4) nor an exchange of signals (claim 5) for determining eligibility. All that Edem states is that '...it is desirable to provide a secondary operational mode which supports limited communications ... and has much lower power requirements than the normal full operational mode or modes.' Thus, there is nothing said about eligibility to enter the lower power mode being based on certain factors, and certainly not any component or protocol or exchange of signals for such.

Prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim. Jamesbury Corp. v. Litton Indus. Products, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985); Atlas Powder Co. v. du Pont, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); American Hospital Supply v. Travenol Labs, 745 F.2d 1, 223 USPQ 577 (Fed. Cir. 1984). A possibility or probability that features of the

prior art contained in the disclosure of the prior art is not enough to establish anticipation. The same characteristics must be a “natural result flowing” from what is disclosed. (Continental Can Co. v. Monsanto Co., 20 USPQ2d 1746, 1749 (Fed Cir. 1991)). Thus, for this reason, all of the claims presently in the application are allowable. Clearly then, claims 1, 4 and 5, the only independent claims in the application, are allowable over Edem.”

Claims 2 and 6-8 are all dependent upon claims 1, 4 or 5 either directly or indirectly and, for the same reasons, are believed to be allowable. Moreover, as pointed out in the previous amendment, claims 6-8 all require selectively identifying and placing portions of a physical device in a low power mode. It is respectfully submitted that Edam *does not* show *selectively* reducing portions of various devices to low power mode. Thus, for these additional reasons, claims 6-8 are believed to be allowable.

Claims 9-20 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Edam in view of U. S. Patent 6,360,327 to Hobson, hereinafter Hobson. This rejection is not thought to be well taken.

First, claims 9-20 are dependent, directly or indirectly, on claims 1, 4 or 5, and Hobson does not cure the above noted defects of Edam. Thus, these claims are allowable for the same reasons. Moreover, Hobson is not dealing with communication systems, but rather with systems having peripheral devices, and which systems have only an “on” position or a “sleep” position. Applicants, on the other hand, are dealing with communication systems having at least two operating modes, in each of which modes data can be transferred. Moreover, Hobson requires a decoy register to switch between the “sleep” mode and the “on” mode. Thus, the operation of the Hobson system is quite different from that of the Applicants. There is just no teaching or

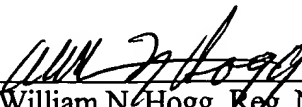
suggestion that the components or operation of the Hobson system would apply to the Applicants' entirely different system, which operates in an entirely different manner.

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1986). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In view of the above, it is believed that each of the claims now in the application is distinguishable, one from the other and over the prior art. Therefore, reconsideration, and allowance of the claims is respectfully requested.

Respectfully submitted,

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